

REMARKS

In the Office Action dated March 17, 2005, 1, 3, 4, 6, 7, 9, 10, 14-16, 18, and 20 were rejected under 35 U.S.C. § 103 over U.S. Patent No. 5,416,610 (Kikinis) in view of U.S. Patent No. 5,349,174 (Van Berkel); claim 5 was rejected under § 103 over Kikinis in view of Van Berkel and U.S. Patent No. 5,585,817 (Itoh); and claims 11-13 were rejected under § 103 over Kikinis in view of Van Berkel.

Applicant acknowledges the indication that claims 2, 8, 17, and 19 would be allowable if rewritten in independent form. These claims have been rewritten in independent form. Claims 2, 17, and 19 have each been amended to delete the words “and converted to data signals” at line 9 of each of the claims (to broaden their scope). The form of claim 8 has been amended to recite an “apparatus,” and the words “and converted to data signals” are deleted at line 10. Claims 2, 8, 17, and 19 are therefore in condition for allowance.

Amended claim 1 is not rendered obvious by the asserted combination of Kikinis and Van Berkel.

In the rejection of claim 1, the Office Action identified the optional cover sheet that can be placed over a hard copy sheet 29 of Kikinis as being the lid layer recited in claim 1.

Note, however, that Kikinis teaches that the cover sheet is “placed over” hard copy sheet 29 to shield the hard copy sheet 29 from ambient light. Kikinis, 3:17-18. However, this cover sheet when placed over the hard copy sheet 29, as taught by Kikinis, does not define an object holding space between a platen layer and a lid layer, where the lid layer and platen layer are spaced apart to enable the object to be moved into and out of the space on at least one side of the scanner screen. In Kikinis, the hard copy sheet 29 is placed over the photosensitive transparent layer 18, followed by placing the cover sheet over the hard copy sheet 29. Therefore, Kikinis does not disclose or suggest the lid layer having the recited arrangement with respect to the platen layer. It is noted that Van Berkel is completely silent on the use of any cover, as Van Berkel teaches the provision of a document directly onto an image sensor. *See* Van Berkel, Fig. 11.

Therefore, the hypothetical combination of Kikinis and Van Berkel does not teach or suggest all elements of claim 1. A *prima facie* case of obviousness therefore cannot be established with respect to claim 1.

Dependent claims are allowable for at least the same reasons. Moreover, the obviousness rejection of claim 5 over Kikinis, Van Berkel, and Itoh has been overcome based on the amendment of claim 1.

With respect to the obviousness rejections of claims 11 and 13 over Kikinis, Van Berkel, and "well known art," Applicant respectfully traverses the taking of official notice with respect to the additional subject matter taught by claims 11 and 13. With respect to claim 11, the Office Action conceded that the hypothetical combination of Kikinis and Van Berkel does not teach or suggest the lid layer being hingedly attached to a scanner screen. However, the Office Action took official notice that such a hinged attachment was well known.

Applicant respectfully disagrees, as there is no suggestion anywhere of any desirability to hingedly attach a cover sheet to a scanner screen in either Kikinis or Van Berkel. A person of ordinary skill in the art reading the teachings of Kikinis and Van Berkel would not have been motivated to modify Kikinis and Van Berkel to achieve the hinged attachment of the lid layer to the scanner screen as recited in claim 11. If a prior art reference exists that suggests the modification of Kikinis and Van Berkel to achieve the claimed invention, Applicant respectfully requests the production of such a reference. Absent such a reference, the *prima facie* case of obviousness would be defective.

Similarly, with respect to claim 13, Applicant also disagrees that it would be well known to attach the scanner screen to the scanner screen holder by a hinged mechanism. In fact, in Kikinis and Van Berkel, there exists no suggestion whatsoever of any desirability to provide any type of hinged connection between the photosensitive transparent layer 18 (Kikinis) or image sensor 1 (Van Berkel) with respect to any type of holder. If a prior art reference exists that suggests the modification of Kikinis and Van Berkel to achieve the claimed invention of claim 13, Applicant respectfully requests the production of this reference. Otherwise, a *prima facie* case of obviousness cannot be established with respect to claim 13.

Newly added independent claim 21 is allowable over the cited references as none of the references disclose or suggest a scanner screen having a first position in which the scanner screen is positioned to receive light from an external light source, and the scanner screen being movable with respect to the holder from the first position to a second position in which the scanner screen is stowed in the holder.


Independent method claim 25 is allowable because none of the cited references disclose or suggest moving a scanner screen from a stowed position in the holder to a second position in which the scanner screen is positioned to receive light from an external light source.

Newly added dependent claims 22-24, 26, and 27 are allowable for at least the same reasons as respective independent claims.

Allowance of all claims is respectfully requested. The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (10004816-1).

Respectfully submitted,

Date: July 13, 2005



Dan C. Hu
Registration No. 40,025
TROP, PRUNER & HU, P.C.
8554 Katy Freeway, Suite 100
Houston, TX 77024
Telephone: (713) 468-8880
Facsimile: (713) 468-8883